

Atty Dkt. No.: STHP-018  
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SEP 12 2006

**REMARKS**

In view of the following remarks, the Examiner is requested to allow Claims 1-21, the only claims pending and under examination in this application.

Claims 3, 4-6, 8, 9, 12, 14, 16, 19 and 21 have been amended to correct their dependencies. Accordingly, no new matter has been added.

As no new matter has been added by way of these amendments, entry thereof by the Examiner is respectfully requested.

As an initial matter, the Applicant notes that page 2 of the Office Action indicates that Claims 4-21 have been withdrawn from consideration. As a restriction/election requirement has not been issued in the above case, the Applicant believes the withdrawal of Claims 4-21 has been made in error. Therefore, the Applicant has responded to the Office Action as if Claims 4 to 21 were not withdrawn from consideration. The Applicant respectfully requests that the Office acknowledge that Claims 4-21 are still pending in the instant application.

***Specification***

As the Examiner suggests, the Applicant has amended the title of the specification to be more descriptive of the instant invention.

Additionally, the Applicant has also taken the opportunity to amend the specification at paragraphs 53, 65, 70 and 80 to correct minor typographical errors. Accordingly, no new matter has been added by way of these amendments.

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### ***Claim Objections***

Claims 16-21 have been objected to under 37 C.F.R. 1.75(c) as allegedly being in improper format. Accordingly, Claims 16-21 have been amended to clarify the claim language. In view of the amendments, the Applicant respectfully requests that these objections be withdrawn.

### ***Claim Rejections – 35 U.S.C. § 102***

Claims 1-6 and 9-11 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Nishimura (USPN 5,137,028).

According to the MPEP, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. See MPEP 2131.

An element of the rejected claims is an indwelling vaginal thermometer. As is widely known in veterinary practices and animal husbandry, an "indwelling thermometer" is one that is implanted into a subject animal or user. This understanding is in accordance with the way the term "indwelling thermometer" is used in the Applicant's specification. According to the Applicant's specification, an indwelling thermometer is a thermometer which is left in a predetermined place for a long period of time. See page 1, paragraph 5.

The Office asserts that Nishimura discloses a vaginal "indwelling" thermometer. However, the Applicant respectfully disagrees and contends that the Office is misrepresenting the cited art. Although Nishimura teaches a thermometer for determining the day of ovulation, nowhere does Nishimura teach that the disclosed thermometer is only meant to be inserted into a vagina nor does Nishimura disclose that

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the thermometer is meant to be indwelling. Rather, the thermometer disclosed by Nishimura is meant to be used at an unspecified location and only for a short period of time during which a measurement is taken. This can be seen clearly with reference to column 4, lines 56 to 60, wherein is stated:

for setting "minute" are arranged. Further below this row, a switch 15 for setting "hour" of the alarm time for notifying a time to measure the body temperature to a person under supervision by alarm and a switch 16 for

As can be seen with reference to the above, the thermometer disclosed by Nishimura includes an alarm. The timer functions to indicate the time at which point the body temperature of a person being supervised is to be measured. Accordingly, the thermometer is designed to be inserted, a measurement taken, and then removed after the measurement is taken. If the thermometer were indwelling, there would be no reason to have an alarm which functions to notify a user of the time to take a measurement. Hence, the thermometer of Nishimura is not an indwelling thermometer.

This assertion is further supported by the fact that in order to accurately determine the day of ovulation, the user must frequently enter or update data into the device, such as bleeding, menorrhagia, discharge, intercourse, fever, doping and the like. See column 4, lines 22 to 49. Such data input requires that the user push buttons on the device in order to record a temperature. In fact, as indicated by column 6, lines 10 to 17, two switches need to be depressed in order to take a measurement. This configuration would make it physically impossible to use the device as a vaginally indwelling thermometer. Hence, the thermometer of Nishimura can not be an indwelling thermometer.

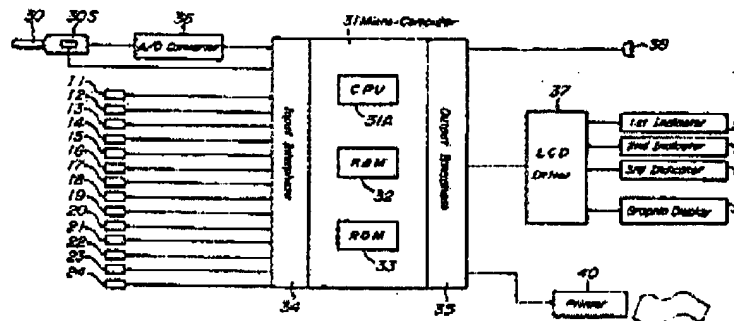
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Additionally, the duration of time during which a measurement is taken is short<sup>1</sup>, for instance, upto 5 minutes. See below:

**RAM (FIG. 2).** However, if the above measurement completion time is less than five minutes, the temperature measurement is continued and the highest temperature after a lapse of five minutes from the starting of this temperature measurement is assumed as the basal body temperature. This value is stored in the memory RAM 32 and a completion signal tone different from the above temperature measurement completion tone is produced.

Accordingly, as the measurements are only taken at periodic time points, over 24 hour periods, there is no reason for the thermometer disclosed in Nishimura to be indwelling.

Furthermore, the thermometer disclosed by Nishimura contains components that would not be included if the thermometer were meant to be indwelling. For instance, the disclosed thermometer is set forth in Figure 2:

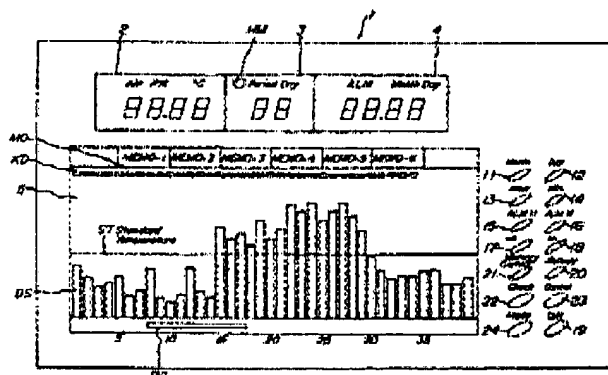


The Applicant contends that Element 30 is the portion of the thermometer that is inserted into the body so as to take a temperature measurement. The Applicant

<sup>1</sup> For instance, the corresponding European Patent to Nishimura, EP 0424102 B1 indicates that a predetermined time is from 30 seconds to 5 minutes. One of skill in the art would not consider a time period from 30 seconds to 5 minutes as being a long period of time, certainly not long enough to consider the Nishimura thermometer indwelling.

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contends that Element 30S is not meant to be inserted into the body. Element 30S is the display screen of Figure 1:



The display screen contains read outs and input buttons for interpreting and inputting data into the device. In order to be readable and to allow a user to push the buttons so as to control the measurement parameters, the display screen 30S would have to be relatively large in comparison to element 30. As such, the Applicant contends that one would not insert this portion of the device into the body. This contention is supported by the fact that one would not be able to view the display screen if the entire thermometer were inserted into the body.

Accordingly, nowhere does Nishimura teach that the disclosed thermometer is a vaginal thermometer or that it is indwelling. In fact, when viewed in its entirety, the disclosure of Nishimura indicates that the thermometer is only used to take measurements at periodic times and for short time durations. Hence, the thermometer disclosed in Nishimura is not left in a predetermined place (e.g., a vagina) for a long period of time and therefore is not indwelling. Because the disclosed thermometer is not a vaginally indwelling thermometer, Nishimura fails to teach every element of the Applicant's claims. Therefore, the Applicant contends that Nishimura does not anticipate the claimed invention and respectfully requests that the 35 U.S.C. § 102(b) rejection of Claims 1-6 and 9-11 be withdrawn.

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***Claim Rejections – 35 U.S.C. § 103***

Claims 7-8 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nishimura in view of Nollen (USPN 3,895,523).

According to the MPEP § 706.02 (j), to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Amended Claims 7 and 8 ultimately depend from Claim 1. As set forth above, an element of the rejected claims is an indwelling vaginal thermometer.

The Office acknowledges that Nishimura does not teach a temperature sensing means that includes a wax or a grease with a melting point close to the temperature threshold. The Office, therefore, relies upon Nollen for its teaching of a disposable thermometer that includes a dye and Vaseline.

However, as set forth above, Nishimura is deficient for failing to teach an indwelling vaginal thermometer. As Nollen was cited for its teaching of a disposable thermometer that includes a dye and Vaseline, it fails to remedy the teachings of Nishimura. Therefore, a *prima facie* case of obviousness has not been established because the cited combination fails to teach every element of the rejected claims, namely, an indwelling vaginal thermometer. Accordingly, in view of this, the Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of Claims 7 and 8 be withdrawn.

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Claims 12-13 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nishimura in view of Hof *et al.* (USPN 4,345,470).

Amended Claims 12 and 13 ultimately depend from Claim 1. As set forth above, an element of the rejected claims is an indwelling vaginal thermometer.

The Office acknowledges that Nishimura does not teach the material from which the thermometer is made or thermochromatic temperature sensing means. The Office, therefore, relies upon Hof for its teaching of a thermometer that is made from plastic and includes an indicator means that is heat sensitive and changes color in response to a temperature change.

However, as set forth above, Nishimura is deficient for failing to teach an indwelling vaginal thermometer. As Hof was cited for its teaching of an indicator means that is heat sensitive and changes color in response to a temperature change, it fails to remedy the teachings of Nishimura. Therefore, a *prima facie* case of obviousness has not been established because the cited combination fails to teach every element of the rejected claims, namely, an indwelling vaginal thermometer. Accordingly, in view of this, the Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of Claims 12 and 13 be withdrawn.

Claim 14 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nishimura in view of Weiland (USPN 5,499,631).

Amended Claim 14 is directed to kit of thermometers.

The Office acknowledges that Nishimura does not teach a kit let alone a kit of more than one temperature sensing means. The Office, therefore, relies upon Weiland to remedy the deficiencies of Nishimura. Weiland, however, does not teach a kit of thermometers. Rather, Weiland teaches a test probe that includes multiple test

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electrodes which are attached to the test probe. Weiland does not disclose a kit, let alone a kit that includes a plurality of the disclosed probes.

As neither Nishimura nor Weiland teach a kit of thermometers, the recited combination fails to teach every element of the rejected claims. Therefore, a *prima facie* case of obviousness has not been established. Accordingly, in view of this, the Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of Claim 14 be withdrawn.

Claim 15 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nishimura in view of Weiland and further in view of Nollen.

Amended Claim 15 ultimately depends from Claim 1. As set forth above, an element of the rejected claims is a kit of thermometers.

The Office acknowledges that Nishimura does not teach a kit of thermometers that sense temperature over a predetermined range. The Office, therefore, relies upon Weiland and Nollen for these teachings.

However, as set forth above, Weiland does not teach a kit of thermometers. Nollen as well does not teach this element. Accordingly, the cited combination fails to teach every element of the rejected claims, namely, a kit of thermometers. Therefore, a *prima facie* case of obviousness has not been established. Accordingly, in view of this, the Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of Claim 15 be withdrawn.



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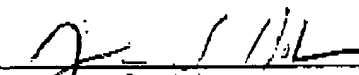
**CONCLUSION**

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 833-7770.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number STHP-018.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date: 9.12.06

By:   
James S. Nolan  
Registration No. 53,393

Date: 9.12.06

By:   
Bret E. Field  
Registration No. 37,620

BOZICEVIC, FIELD & FRANCIS LLP  
1900 University Avenue, Suite 200  
East Palo Alto, California 94303  
Telephone: (650) 327-3400  
Facsimile: (650) 327-3231

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